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John S. Beulick
Armstrong Teasdale LLP
One Metropolitan Square, Suite 2600
St. Louis, MO 63102

In re Application of PNIOK et al :
U.S. Application No.: 10/019,808 :
Int. Application No.: PCT/EP00/00395 :
Int. Filing Date: 19 January 2000 :
Priority Date: 31 March 1999 :
Attorney Docket No.: 75DE00606 :
For: CURRENT METER :

DECISION

This is in response to the "Petition to Revive Patent Application for Unintentional Failure to Timely File the Basic National Fee (35 U.S.C. 371)" filed 13 January 2003 and the "Petition in Support of Filing on Behalf of Nonsigning Inventor (37 C.F.R. § 1.47)" filed 07 October 2002.

BACKGROUND

On 19 January 2000, applicant filed international application PCT/EP00/00395, which claimed priority of an earlier Germany application filed 31 March 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 12 October 2000. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 October 2001 (30 September 2001 was a Sunday).

International application PCT/EP00/00395 became abandoned as to the United States of America at midnight on 01 October 2001 for failure to timely file the basic national fee.

On 07 October 2002, applicant filed the present petition under 37 CFR 1.47(a).

On 16 December 2002, the DO/EO/US mailed a Notice of Abandonment.

On 13 January 2003, applicant filed the present petition under 37 CFR 1.137(b).

DISCUSSION

I. Petition under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required basic national fee under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

Therefore, applicant has satisfied all the requirements of 37 CFR 1.137(b).

II. Petition under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by inventors Thomas Pniok and Gerd Jodehl each on his/her own behalf and on behalf of the nonsigning inventor Heinz Wollny.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers

(specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The present petition states that inventor Wollny refuses to sign the application papers. Although petitioner has provided evidence of an express oral refusal to sign (see affidavit of Verena Khinda), petitioner has not demonstrated that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to Wollny for signature. Thus, it cannot be concluded at the present time that Wollny refuses to join in the application.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.137(b) is GRANTED.

For the reasons set forth in §II above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of the petition under 37 CFR 1.47(a) is desired, a proper response must be filed within TWO (2) MONTHS from the mailing date of this decision. Failure to timely file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459